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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,837	03/20/2001	Shunpei Yamazaki	12732-022001 / US4790	8400

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EXAMINER

CHIANG, JACK

ART UNIT PAPER NUMBER

2642

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/81837

Applicant(s)

Yamazaki ET AL.

Examiner

G. Chiang

Group Art Unit

2642

#9

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 4-13-04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-104 is/are pending in the application.
- Of the above claim(s) 3-104 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-2 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

RESTRICTION

1. The restriction dated on 02-13-04 is made final.

Applicant had elected claims 1-2. All other claims have been withdrawn from further consideration.

A new claim 104 has been added.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, drawn to a specific key having LED, classified in class 379, subclass 433.01+.
- II. Claim 104, drawn to keys having display images, classified in class 345, subclass 81.

3. Inventions Groups I and II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group required a specific LED which is not required in Group II. The subcombination has separate utility such as in the computer area having any display technology for the keys.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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5. Newly submitted claim 104 is directed to an invention that is independent or distinct from the invention originally claimed claims 1-2 for the reasons as set forth above.

Since applicant has elected claims 1-2 on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 104 has been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

CLAIMS

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danielson (WO 94/19736) in view of Jacobsen et al. (US 6232937).

Regarding claims 1-2, Danielson discloses an electronic device comprising:

A display portion having active elements which has liquid crystals (15);

The operation keys (16);

The direction of an image displayed is switchable between a first orientation and a second orientation (figs. 2-3).

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Danielson differs from the claimed invention in that it does not explicitly show that the keys having LEDs.

However, it is commonly seen that image is displayed by LED matrix. This is shown by Jacobsen (figs. 5e, 5g), and an image displayed can be switchable between a first orientation and a second orientation (figs. 9b, 9e).

Hence, the concept of switching the keys from a first orientation to a second orientation is well taught by Danielson (figs. 2-3). It would have been obvious for one skilled in the art to apply Jacobsen's method of the LED matrix in Danielson, such that the displayed image can be controlled by the switching/control of the LED matrix, this method is notoriously well known in the art, and yet the basic concept of providing the keys in different orientations is substantially unchanged.

Danielson further differs from the claimed invention in that show audio input/output portions.

However, Jacobsen further shows the audio input/output portions (i.e. 1234, 1230 in fig. 8h).

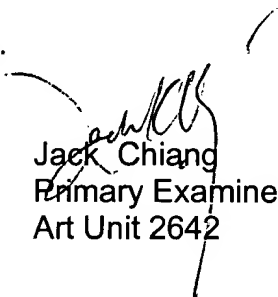
Hence, it would have been obvious for one of ordinary skill in the art to apply the combination of Danielson and Jacobsen in the phone environment which usually have audio input/output portions, this simply can be considered as an intended use of the combination as it is shown in Jacobsen's phone environment, because it is commonly seen that today's electronic devices having various functions, including phone function.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack Chiang
Primary Examiner
Art Unit 2642